

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed
		10/092,333	March 06, 2002
		First Named Inventor	
		Imed GHARSALLI	
		Art Unit	Examiner
		2629	Kimnhun NGUYEN
<p>Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>56,939</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

Signature

Timothy McNulty

Typed or printed name

202-408-4397

Telephone number

January 3, 2007

Date

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT
Customer No. 58,982
Attorney Docket No. 08350.1484-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Imed GHARSALLI et al.) Group Art Unit: 2629
)
Application No.: 10/092,333) Examiner: Kimnhung NGUYEN
)
Filed: March 06, 2002) Confirmation No. 9000
)
For: INPUT/OUTPUT INTERFACE)
CONTROL)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections applied against this application in the Office Action mailed October 3, 2006. This Request is being filed concurrently with a Notice of Appeal.

I. Compliance With Requirements For Submitting a Pre-Appeal Brief Request for Review

This submission complies with the requirements for requesting a pre-appeal brief review because: (i) the present application has been at least twice rejected; (ii) this Request is being filed concurrently with a Notice of Appeal and (iii) prior to the filing of an Appeal Brief; and (iv) this Request is five (5) or less pages in length and sets forth legal and/or factual deficiencies in the outstanding final rejections. *See* Official Gazette Notice, July 12, 2005.

II. Status of the Claims

Claims 1-20 are pending. In the Office Action mailed October 3, 2006 ("the Office Action"), claims 2-5, 6, and 7 stand rejected under 35 U.S.C. § 112, second paragraph, claims 1-

4, 8-12, 14, 15, 17, and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,854,554 to Brandt et al. (“Brandt”), and claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Brandt in view of U.S. Patent Application No. 2003/0060906 to Kim (“Kim”). Claims 5-7, 13, 19, and 20 were objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form.

III. Grounds for Traversing the Rejections

A. The Rejection of Claims 2-5, 6, and 7 is Legally Deficient Because these Claims are Not Indefinite

Applicants respectfully submit that the Examiner has misapplied the standard for indefiniteness. In the Office Action, claims 2-5 were rejected as allegedly having insufficient antecedent basis for the phrase “receiving a desired command signal” in lines 1-2 thereof. However, independent claim 1, from which each of claims 2-5 depends, recites the exact phrase “receiving a desired command signal” in line 3 thereof. Additionally, in the Office Action, claims 6 and 7 were rejected as allegedly having insufficient antecedent basis for the phrase “adjusting a parameter of an undesired command signal” in lines 1-2 thereof. However, line 6 of independent claim 1, from which each of claims 6 and 7 depends, recites the exact phrase “adjusting a parameter of an undesired command signal.” Applicants submit that the respective phrases in claim 1 provide sufficient antecedent basis for the respective phrases in each of claims 2-5, 6, and 7 and that claims 2-5, 6, and 7 are definite. Accordingly, Applicants submit that the indefinite rejections set forth in the Office Action are legally deficient and request that these rejections be withdrawn.

B. The Rejection of Claims 1-4, 8-12, 14, 15, 17, and 18 is Legally Deficient Because Brandt Does Not Anticipate these Claims

In the Office Action, the Examiner contends that Brandt discloses, in column 5, lines 52-67,

“a potential condition for receiving an undesired command signal (see signal of joystick 104) from at least one other control input...[and]...also discloses adjusting a parameter of an undesired command signal received from the at least one other control input in response to the potential condition, because Brandt discloses a plurality of settable parameter (adjusting a parameter) by adjusting the high or low speed fashion.”

See page 9, lines 3-8 of the Office Action. Applicants submit that the Examiner has failed to establish that Brandt discloses each and every element of at least independent claims 1, 8, and 18, and thus did not meet the burden required under MPEP § 2131. Applicants submit that column 5, lines 52-67 of Brandt discloses setting parameters, including deadband, *prior to use* and, after the parameters are set, they are not subsequently changed. That is, Brandt discloses the ability for a user to set a parameter prior to use by changing software, thereby establishing a constant parameter that remains as originally set during actuation of the joysticks. Brandt is completely silent regarding any changing of a parameter after it has been set and, thus, cannot disclose such a feature.

Therefore, contrary to the Examiner's assertions, Brandt does not disclose, with respect to independent claim 1, determining a potential condition for receiving an undesired command signal from at least one other control input and adjusting a parameter of an undesired command signal received from at least one other control input in response to the potential condition. Additionally, Brandt does not disclose, with respect to independent claim 8, determining a potential condition for receiving an undesired command signal from at least one other control input and modifying a parameter of the second command signal in response to the potential condition. Furthermore, Brandt does not disclose, with respect to independent claim 18, selectively passing the second command signal through a control function to selectively control a parameter of the second command signal as a function of the first command signal and subsequently removing the control function from the second command signal.

Accordingly, the Examiner's allegation that Brandt anticipates independent claims 1, 8, and 18 contradicts the explicit disclosure of Brandt. As a result, the Examiner's reliance on Brandt is misplaced and the rejections of independent claims 1, 8, and 18 are legally deficient. Thus, Applicants request that the rejections of independent claims 1, 8, and 18 be withdrawn and the claims allowed. Additionally, rejected claims 2-4, 9-12, 14, 15, and 17 depend from either independent claim 1 or 8. Thus, the rejection of dependent claims 2-4, 9-12, 14, 15, and 17 is also legally deficient for at least the same reasons set forth above in connection with claims 1 and 8.

Moreover, the rejections of claims 1, 8, and 18 are legally deficient to the extent the Examiner alleges that Brandt's setting of parameters prior to use is the same as the steps and elements recited in claims 1, 8, and 18.

Although the Examiner is entitled to interpret claim terms broadly, such interpretation cannot be unreasonable. Indeed, MPEP § 2111 indicates “pending claims must be given their broadest reasonable interpretation consistent with the specification.” While the Examiner may not be required “to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit,” the Examiner is required to apply “to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” *Id.* Accordingly, for example, the broadest reasonable interpretation of the receiving, determining, adjusting, and delivering steps recited in claim 1, must be consistent with the interpretation of these steps that those skilled in the art would reach. *See id.*

The Examiner incorrectly asserts that the settable parameters disclosed by Brandt are equivalent to adjusting a parameter of an undesired command signal, as recited in claim 1. This assertion is not consistent with the interpretation of the phrase in context of Applicants’ specification and in view of the plain meaning of the phrase in light of the other phrases in the method of claim 1 (e.g., receiving and determining steps). The same problem resonates to other independent claims 8 and 18 and the Examiner’s application of the cited art. The Examiner ignores reasonable interpretations of Applicants’ claim terms, such as adjusting a parameter of an undesired command signal received from the at least one other control input in response to the potential condition, as recited in claim 1, in the context of not only the specification, but the known meaning in the art. Doing so violates at least the policies governed by the MPEP and further renders the rejection of claims 1, 8, and 18 legally deficient.

C. The Rejection of Claim 16 is Legally Deficient Because the Examiner Did Not Establish a *Prima Facie* Case of Obviousness

In the Office Action, the Examiner contends that “Kim discloses the undesired command signal after an elapsed period of time,” citing Kim at paragraph [0002]. Furthermore, the Examiner alleges that “[i]t would have been obvious...to implement the undesired command signal after an elapsed period of time *as taught by Kim.*” (emphasis added) *See* lines 8-13 of page 7 of the Office Action. Initially, the rejection of claim 16 is legally deficient because contrary to MPEP § 2143, Kim does not overcome the deficiency noted above in connection with claims 1, 8, and 18 with respect to Brandt. Additionally, the Examiner’s reliance on Kim is

misplaced. For example, paragraph [0002] of Kim merely identifies that simultaneous operation of two actuators with the same hand establishes an elapsed period of time between the operation of the two actuators. That is, the two actuators cannot necessarily be actuated simultaneously with the same hand. However, merely mentioning that “an elapsed period of time” exists, does not establish that Kim teaches, with respect to claim 16, removing an adjusted parameter from an undesired command signal after an elapsed period of time. Indeed, the cited portion, or any other portion of Kim is not relevant to removing an adjusted parameter. Accordingly, the rejection of claim 16 is legally deficient, should be withdrawn, and the claim allowed.

IV. Conclusion

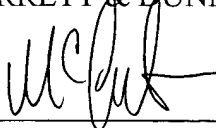
The above arguments with respect to the rejections based on Brandt and Kim were previously presented in the Reply filed July 12, 2006. Yet the Examiner failed to address these assertions by Applicants. MPEP § 707.07(f) requires the Examiner to “take note of the applicant’s argument and answer the substance of it” when Applicant traverses any rejection. The Examiner has not met this burden by failing to address the substance of all of Applicants arguments presented in the July 12 Reply.

In light of the above arguments and those presented in the July 12 Reply, the rejection of claims 2-5, 6, and 7 for indefiniteness, the rejection of independent claims 1, 8, and 18, and dependent claims 2-4, 9-12, 14, 15, and 17 as being anticipated by Brandt, and the rejection of claim 16 as being unpatentable over Brandt in view of Kim are each legally deficient. Because the Examiner’s rejections of claims 1-12 and 14-18, as set forth in the Office Action, include legal deficiencies, Applicants are entitled to a pre-appeal brief review of the Office Action. Based on the foregoing arguments, Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 3, 2007

By: 
Timothy McAnulty
Reg. No. 56,939